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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/283,645 | 04/01/99 | KHETANI | CELG-0119 |

HM12/1025

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EXAMINER

CHANG, C

ART UNIT

1625

PAPER NUMBER

DATE MAILED: 10/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.
09/283,645

Applicant(s)
Khetani

Examiner
Celia Chang

Art Unit
1625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Oct 10, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

4. ☐ Applicant's reply has overcome the following rejection(s): _____
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attachment
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-8, 10-13, and 15
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____

CEILA CHANG
PRIMARY EXAMINER
GROUP 1200

Art Unit: 1625

Attachment to Advisory

The request for reconsideration filed by applicants in Paper No. 14, dated Oct. 10, 21001 has been considered carefully.

Applicant's arguments with respect to the 102(b) rejection has been considered.

Applicants argued that the Jursic reference did not disclose 'acid' or "acid resolving agents", or "salt" as required by the claims, thus, anticipation can not be made.

Applicants' attention is drawn to that, in claim 1, the required elements are both l-threo and d-threo compounds be present which are found on p. 1712, an acid resolving agent be present which are found on p.1712 reagent, p.1713 acidity, and reaction is in a solvent which is found on p.1713, chloroform. Therefore, all the elements of the claims are found in one reference and anticipation was found.

Applicants' attention is drawn to that, claim 15, wherein in addition to the elements of base claim 1, the salt be isolated, which has been pointed out in the previous office action that on p.1713 it was disclosed by Jursic that amide-resolving acid complexes were separated. The comparison of unseparated enantiomer (NMR without resolving agent) and complexes with resolving agent indicated separation of enantiomers and the paragraph below the comparative data stated that resolving agent 4-6 are only sufficient for qualitative work i.e. resolving agent 1-2 are good for qualitative work as well as quantitative recovery. Please note that NMR is a tool of measurement, the meaning of the result is described clearly on p. 1713.

The acid-base complexes were described and was structurally delineated on page 2 of the previous office action. Applicants should compare the structural analogue with the protonated alcohol complex i.e. salt with p. 33 of Morrison and Boyd text as attached.

Applicants's arguments with respect to the 103(a) rejection has been considered.

Applicants argued that the previous office action provided no evidence that tartranilic acid and tartaric acid have functional equivalency.

Applicants attention is drawn to the US 4,410,700 reference cited in the previous office actions wherein the rejection was maintained (see paper No. 10, p.3) which taught that for enantiomeric separation tartaric and tartranilic acids are functionally optional reagents.

Applicants did not file terminal disclaimer to obviate the obviousnes type double patenting. Therefore, the request for reconsideration is a repeat of all the issues which have been dealt clearly in the previous office actions.